



PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Thomas V. JOHNSON et al.

Application No.: 09/895,077

Filed: July 2, 2001

For: METHODS AND SYSTEM FOR EFFICIENT
ASSOCIATION TRAVERSALS

Group Art Unit: 2171

Examiner: E. Leroux

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Commissioner for Patents
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Technology Center 2100

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated October 31, 2003, the Examiner required restriction under 35 U.S.C. § 121 between claims 1-5 (Group I), 6-10 (Group II(a)), 11-15 (Group II(b)), 16-17 (Group II(c)), 18-20 (Group II(d)), 21-25 (Group II(e)), 26-28 (Group II(f)), 29-33 (Group II(g)), 34-36 (Group II(h)), 37-44 (Group II(i)), 45-46 (Group II(j)), 47-49 (Group II(k)), 50-51 (Group II(l)), 52 (Group II(m)), 53 (Group II(n)), and 54-56 (Group II(o)).

Applicants provisionally elect to prosecute Group I, claims 1-5 with traverse.

I. The Examiner's Request for Oral Election

The Examiner contacted Applicants' representative on October 7, 2003 to request an oral election for this application. When asked, the Examiner did not and could not present any basis for the proposed restriction. Indeed, the Examiner could not identify the particular groups that were subjected to the proposed restriction.

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Accordingly, the Applicants' representative could not make an election because a proper restriction was not set forth by the Examiner. In response, the Examiner indicated he would provide a written restriction requirement.

II. The Asserted Groupings are not Distinct

The Examiner asserts that Groups I and II(a)-(o) are related as combination and subcombinations. To establish that these groups are distinct, the Examiner must show two-way distinctness and provide reasons for insisting on restriction (i.e., separate classification, field of search, etc.). See M.P.E.P. § 806.05(c). The Examiner has failed to meet this burden.

a. The Particulars of the Subcombinations

To show distinctness, the Examiner asserts that the combination (i.e., Group I) does not require the particulars of the sub-combinations (i.e., Groups II(a)-II(o)) "because the combination can be used to ascertain the association between data/methods pertaining to the objects." Applicants traverse the Examiner's position for the following reasons.

First, the subcombinations (i.e., Groups II(a)-II(o)) can be used to ascertain the association between data/methods pertaining to objects. In fact, because claims 6-54 include recitations similar (or in some cases identical) to those of claims 1-5, the combination may require the particulars of claims 6-54. Applicants' position is supported by the fact that the Examiner has separated some claims that are identical in scope, but claimed as a different category of invention (i.e., system, method, computer-readable medium, etc.). For example, claim 37 recites a computer-readable medium including instructions for performing a method that includes the same steps as those

recited in claim 1. Yet, the Examiner concludes that claim 37 is a subcombination of claim 1, and thus is distinct. This assertion is clearly incorrect.

Second, the claims recited in Groups II(a)-II(o) can all be used to ascertain the association between data/methods pertaining to objects. (e.g., claim 11-“performing association traversals in an object-oriented environment”). Indeed, the Examiner’s assertion that the combination does not require the particulars of the subcombinations (e.g., Groups II(a)-II(o)) is unsupported and contradicted by the recitations of the claims included in Groups I and II.

b. The Combination has Similar Utility as the Proposed Subcombinations

The Examiner also attempts to show distinctness by stating that the subcombinations (i.e., Groups II(a)-II(o)) have separate utility “such as analyzing data contained via the Internet.” (see Office Action, page 4, lines 3-4). Applicants disagree with the Examiner for the following reasons.

First, the Examiner’s exemplary utility is so broad as to encompass many types of systems and processes that may be implemented by the various embodiments of the present invention. Nonetheless, the Examiner’s hypothetical subcombination utility (which is not even based on any utility stemming from Applicants’ disclosure) applies to the very combination the Examiner is attempting to distinguish. That is, using the Examiner’s hypothetical utility, the asserted combination (i.e., Group I), may also analyze data obtained via the Internet. In fact, the flaw in the Examiner’s position is clearly shown by comparing the inventions recited in claim 1, included in Group I, and claim 37, which the Examiner has placed in Group II(i). Both claims recite a method

comprising the steps of "creating, for the first instance, a reverse link that defines a relationship between the first instance and the association; and determining a relationship between the first and second instances based on the reverse link." It is unclear to Applicants how the Examiner finds distinctness between claims that include the same method steps.

Further, the Examiner has not provided evidence that the combination (i.e., Group I) is patentable without the details of the subcombination. In fact, it is unclear what the Examiner asserts as the combination of subcombinations. Applicants submit that claims 1-56 are not distinct, but rather vary in scope within a single type of invention, which is directed to methods and systems for performing association traversals.

c. The Asserted Groupings are not Divergent Classified Subject Matter

The Examiner attempts to show distinctness by asserting that Groups I and II(a)-II(o) have separate utility and that they are directed to subject matter classified in divergent classes/subclass combinations. Applicant disagrees.

In reaching the conclusion, the Examiner appears to read just the preamble of the independent claims of the application, without considering the recitations in the body of these claims. For example, the Examiner has identified Group I as directed to "a method for determining relationship between objects," which is the exact language of the preamble of claim 1, and identified Group II(a) as directed to "a method for maintaining reverse links in an object-oriented environment," which is the exact language of the preamble of claim 6. The Examiner, however, cannot merely look at the preamble; he must consider the scope of the subject matter defined by the body of

each respective claim when classifying claims. When properly considered, claims 1-5 are not distinct from any combination of claims 6-56.

For instance, the Examiner asserts that Group II(a) is distinct from Group I because the latter maintains reverse links in an object-oriented environment. If this is the case, a proper review of claim 1 shows that the claim is also directed to reverse links in an object-oriented environment. Moreover, construing these claims in vice versa fashion, the Examiner asserts Group I is distinct from Group II(a) because Group I is drawn to a method for determining a relationship between objects. If this is the case, a proper review of claim 6 shows that it is drawn to a similar invention (i.e., pointers that each references an individual instance of the association class).

Accordingly, it is clear that the Examiner's asserted groupings between claims 1-5 and 6-10, for example, are unsupported by proper evaluation of the claim's recitations, and should be withdrawn. The same problem may be found with Groups II(b)-II(o).

Additionally, the Examiner attempts to show distinctness by classifying each group in different class/subclasses. These classifications are improper and inconsistent.

The Examiner has classified claims that include identical recitations in different subclasses. For example, claim 1 is classified in class 707, subclass 1, while its counterpart system claim 21, and computer-readable medium claim 37 are classified in class 707, subclass 1 and class 707, subclass 103, respectively. The Examiner's classifications are clearly incorrect and are an indication of the inconsistent reasoning for restricting claims 1-56. The same inconsistencies can be found for claim 6 and its corresponding system and computer-readable medium claims 26 and 42, which are

classified in class 715, subclass 501.1, class 370, subclass 335, and class 707, subclass 103.

Another indication of the inconsistency and impropriety of the Examiner's attempts to classify claims 1-56 in divergent subject areas can be shown by reviewing claims 37 and 42, which are included in Group II(i). As explained, claim 37 is a computer-readable medium claim corresponding to claim 1. That is, claims 1 and 37 are identical in scope except for the fact that claim 37 is recited as a computer-readable medium including instructions for performing a method similar to that recited in claim 1. Also, as explained, claim 42 is a computer-readable medium claim corresponding to claim 6. A brief review of these claims clearly shows this relationship. The Examiner has grouped claims 37 and 42 in the same group (i.e., Group II(i)). Yet, the Examiner asserts that claims 1 and 6 are distinct. See Office Action, page 2, lines 3-6. The inconsistency in these groupings and classifications cannot be reconciled.

Further, the Examiner asserts that each of the groups are classified in various classes and subclasses. As explained, claims 1-56 are all directed to a single invention with varying scopes. Any attempts to classify the claims in different subclasses is improper. For example, the Examiner classifies claims 26-28 (i.e., Group II(f)) in class 370, subclass 335. At the same time, the Examiner classifies claims 6-10 in class 715, subclass 501.1. As explained, claim 26 is a system claim corresponding to method claim 6. This inconsistency also cannot be reconciled.

Also, the Examiner's classifications are improper. For instance, the Examiner classifies Group II(f) in class 370, subclass 335. This subclass is directed to systems or methods for:

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